

### **REMARKS**

Claims 1 through 28 are pending in this application. Claim 1 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

#### **I. Information Disclosure Statement**

The Examiner stated that the information disclosure statement (IDS) submitted on 18 April 2001 has been considered, however, foreign patent documents KR1999-48136 and JP9-305381 have not been considered as no translation of any part of the document has been provided.

Respectfully, however, under 37 CFR §1.98 no such translation is required here especially since 37CFR§1.98 (a) (3) (ii) states that a copy of the translation *if* a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). Therefore, the Examiner is required to consider the foreign patent documents KR1999-48136 and JP9-305381. Furthermore, since the Examiner has not considered the KR1999-48136 and JP9-305381, under 37CFR1.104, the Examiner office action of paper no. 4 is incomplete.

#### **II. Claim Rejections - 35 USC §102**

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim

is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

1. Claims 1, 3-5, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida. The Applicant respectfully traverses.

Regarding claim 1 the Examiner states that Yoshida teaches:

a computer system comprising a first data storage unit storing a first program and a second program ("a computer usable medium having computer readable program code ... software to be installed into said computer, the computer readable program code means including: first computer readable program code means ... second computer readable program code means..." in col. 3 lines 38-47); a second data storage unit storing a product key of the first program according to the second program, the product key accommodating an installation of the first program (Note Figure 1, item 13 and the corresponding sections of the disclosure. The decryption key is a key associated with the installed product, and as such is a product key.); a third program stored in the first data storage unit for reinstalling the first program, the third program reading the product key of the first program stored in the second data storage unit, when a product key from the third program and the product key stored in the second data storage unit are identical ("such that the decryption key stored in the memory device is utilizable in decrypting the encrypted software at a time of re-installing the encrypted software" in col. 4 lines 13-15. Further, this is performed by the "decryption key retrieval program" as stated in

col. 6 line 27. Finally, this reinstallation occurs "when the appropriate decryption key exists in the decryption key memory unit..." as stated in col. 11 lines 59-60) substantially as claimed.

However, Yoshida '862 fails to disclose a third program stored in the first data storage unit for reinstalling the first program, the third program reading the product key of the first program stored in the second data storage unit, *when a product key from the third program and the product key stored in the second data storage unit are identical*. The Examiner states that reinstallation occurs "when the appropriate decryption key exists in the decryption key memory unit..." as stated in col. 11 lines 59-60) substantially as claimed, however, appropriate key being in decryption key memory unit is not the same as a product key from a third program and the product key stored in the second data storage being identical. Such specifics are not disclosed by Yoshida '862.

Moreover, the first and second programs mentioned by the examiner are not as claimed in claim 1. Col. 3, lines 38-47 mentions a first computer readable program code means causing a computer to search the decryption key in a memory device and the second program acquiring the decryption key from a distribution source of the encrypted software when the decryption key is not found.

However, as seen in the specification of Yoshida '862, "The user receives the decryption key in exchange for the payment of the software usage charge for a desired software, and installs this software into a hard disk device of his own computer by decrypting the encrypted software content using the received decryption key." Therefore, Yoshida '862 concerns a decryption key used for decrypting the software. The Examiner states that the decryption key is a key associated with the

installed product, and as such is a product key. However, the present invention claims a product key and not a decryption key. As mentioned in the present invention, “product key for the installed OS program is inputted, installation of the OS program is continued”. The product key accommodates the continued installation of a program while the decryption key is for decryption of a program only. The standard for anticipation is high and as mentioned in MPEP 2131, the *identical invention* must be shown in as complete detail as is contained in the patent claim and here this is not the case.

2. Regarding claim 3, the Examiner states that the rejection of claim 1 is incorporated, and further, Yoshida discloses a first data storage unit comprising a first unit storing the first program, and a second unit storing the third program as claimed (Note Figure 1, items 12 and 13 and the corresponding sections of the disclosure).

However, looking at figure 1 and references 12 and 13, reference 12 concerns a hard disk drive and reference 13 is a memory unit of the hard disk drive 12 for the decryption key. However, this does not disclose a first unit storing the first program (the program with the product key) and the second unit storing the third program (program for reinstallation). The storage unit for the reinstallation program is not disclosed.

Moreover, figure 1 is showing that the decryption key is actually stored in the same memory unit as the program to be installed as suggested by the Examiner. The separate memory units do not exist as the decryption key is only in a memory region of the hard disk drive. As mentioned in col. 5, line 67 to col. 6, line 2, “On this hard disk device 12, the operating system and various application

programs to be executed on the personal computer 11, and/or various data files are installed. In addition, in a memory region of this hard disk device 12, a decryption key memory unit 13 is provided." All items are actually on the same memory unit but in a different memory region of that same hard disk drive.

3. Regarding claim 4, the Examiner states that the rejection of claim 3 is incorporated, and further, Yoshida discloses the second program being stored in the first unit or the second unit as claimed (Note Figure 7 and the corresponding sections of the disclosure and the decryption key management system includes the decryption key storing program, as stated in col. 7 line 66 to col. 8 line 3).

However, again as mentioned for claim 3, in figure 7 of Yoshida '862, the first program and the key are on the same memory unit when the decryption key management unit is on the personal computer 11 and according to MPEP 2131 as related to 35USC§102, all the features must be disclosed as arranged in the claim.

4. Regarding claim 5, the Examiner stated that the rejection of claim 3 is incorporated, and further, Yoshida discloses the second unit being a re-writable magnetic disk storage device or an optical storage device as claimed ("The storage medium may include ...magneto-optical disks ... magnetic or optical cards, or any other suitable media..." in col. 12 lines 43-56).

However, looking at col. 12, lines 43-56, the optical storage device is for storing the computer program product and the decryption key according to lines 43-47 of col. 12 which is not the same as a first data storage unit for the first and second programs and second data storage unit storing the product key.

5. Regarding claim 10, the Examiner stated that the rejection of claim 1 is incorporated, and further, Yoshida discloses the second program being installed in a hard disk drive storing the first program and application programs as claimed (Note Figure 7 and the corresponding sections of the disclosure. The decryption key management system includes the decryption key storing program, as stated in col. 7 line 66 to col. 8 line 3).

However, again as seen in figure 7, the decryption key memory unit is only a memory area of the same hard disk with the program associated with the key that helps the program to be installed as 12 includes the decryption key-1 to n and software content-1 to n. On the other hand the first program is on a first data storage unit and the product key is on the second data storage.

6. Regarding claim 11, the Examiner stated that the rejection of claim 1 is incorporated, and further, Yoshida discloses erasing the second program when the product key is stored in the second data storage unit as claimed ("the software content of this software is deleted ... while the corresponding software ID and decryption key are maintained..." in col. 9 lines 1-4).

However, looking at col. 9, lines 1-4, Yoshida fails to disclose the second program being erased when the product key is stored in the second data storage unit. Yoshida only discloses "In case of deleting a certain software, only the software content of this software is deleted by the decryption key management unit 64.

### **III. Claim Rejections - 35 USC § 103**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida in view of the Microsoft Press Computer Dictionary, Second Edition. The Applicant respectfully traverses.

1. Regarding claim 6 the Examiner stated that the rejection of claim 1 is incorporated, and further, Yoshida does not disclose the product key being a bar code-readable signal. The Microsoft Press Computer Dictionary, Second Edition discloses that bar code-readable signals were well known in the art at the time, as disclosed on page 37 of the dictionary, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary.

Respectfully, the use of the Microsoft press computer dictionary as a reference is highly irregular and improper form of rejection.

Dictionaries have been used to clarify the meaning of words in a reference but an actual prior art reference is highly improper. If this was allowed then only patents that do have a dictionary defined feature can be patented as most parts of a whole in patents can probably be seen in an unabridged dictionary of sorts.

Moreover, just because the Microsoft dictionary teaches or suggest a product key being a bar code-readable signal does not mean that to should be combined with Yoshida. The first point in MPEP 706.02(j) states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular" without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Respectfully, stating that to "it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary" is not a proper suggestion or motivation under the MPEP 706.02(j) because it is not sufficiently clear and particular.

Therefore, respectfully, this is an improper rejection.



Even if the dictionary was used as an actual reference, Page 37 of the Microsoft Dictionary only gives a definition of a bar code, but does not specifically teach or suggest the actual product key being bar code readable. No such actual teaching or suggestion of the product key being bar code readable is made. The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964).

The Examiner stating that the bar code-readable signals being well known in the art at the time by using the Microsoft dictionary does not teach or suggest the product key being bar code readable.

Therefore, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with Yoshida and not just a dictionary definition.

2. Regarding claim 8, the Examiner stated that the rejection of claim 1 is incorporated, and further, Yoshida discloses that the storage medium may include any suitable media for storing electronic instructions, including RAMs and ROMs and magneto-optical disks. The Examiner admits that Yoshida does not explicitly disclose the second data storage unit being an extended complementary metal-oxide semiconductor random-access memory, but that the Microsoft Press Computer Dictionary, Second Edition discloses that the use of CMOS RAM was well known in the art at the time of the invention as disclosed on page 77 of the dictionary, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CMOS RAM in the system disclosed by Yoshida, for the purpose of storing information while using very low power consumption, as disclosed on page 77 of the dictionary.

Again, the Examiner is improperly using a dictionary as a reference to teach or suggest a feature of the present invention. There is also no motivation or suggestion to include a CMOS RAM in Yoshida, especially when the Examiner admits the CMOS RAM is not even close to being taught or suggested. Here, the Examiner is even using the definitions of parts as motivation to combine which is improper and generalized and not particular to the present invention.

Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with Yoshida and not just a dictionary definition.

3. Regarding claim 9, the Examiner stated that the rejection of claim 8 is incorporated, and further, Yoshida does not disclose the extended complementary metal-oxide semiconductor random-access memory having an auxiliary power source, but that the Microsoft Press Computer Dictionary, Second Edition discloses that the use of CMOS RAM with an auxiliary power source, providing the ability to preserve stored information when power is removed was well known in the art at the time of the invention as disclosed on page 77 of the dictionary (the CMOS RAM is powered by an external battery source) and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CMOS RAM in the system disclosed by Yoshida, for the purpose of storing and retaining information while using very low power consumption when power is removed from the system.

Again, the Examiner is improperly using a dictionary as a reference to teach or suggest a feature of the present invention. There is also no motivation or suggestion to include a CMOS RAM having an auxiliary power source in Yoshida, especially when the Examiner admits the CMOS

RAM is not even close to being taught or suggested. Here, the Examiner is even using the definitions of parts as motivation to combine which is improper and generalized and not particular to the present invention.

Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with Yoshida and not just a dictionary definition.

Furthermore, Yoshida is actually teaching away from an auxiliary power source, as Yoshida teaches the key being on the same hard disk drive as the program being installed. According to MPEP §2145, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of Yoshida cannot be just ignored because according to MPEP §2141.02, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)." There is no motivation to attach an auxiliary power source to the hard disk drive in Yoshida or any actual prior art reference that could be combined.

B. Claim 7, 15, 17 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as Venkatesan. The Applicant respectfully traverses.

Regarding claim 7, the Examiner stated that:

the rejection of claim 1 is incorporated, and further, Yoshida discloses obtaining a new product key when a product key from the third program and the product key stored in the second data storage unit are not identical ("When the appropriate decryption key does not exist in the decryption key memory unit, the communication program o the installer is executed to carry out the decryption key acquisition processing..." in col. 11 lines 21-24). Yoshida further discloses "urging the acquisition of the decryption key to the user by means of a screen display of a message..." in col. 11 lines 35-36.

Yoshida does not explicitly disclose a user directly inputting the product key into an information input window.

Venkatesan discloses in an analogous product key-based installation system a user directly inputting the product key into an information input window as claimed ("will prompt the user to enter the indicia ... the user, in response to this prompt, will then manually enter, typically through a keyboard associated with computer ... the specific 25-digit alphanumeric indicia..." in col. 7 lines 58-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to directly input the product key in the system disclosed by Yoshida, as this would allow a user to authenticate and install the software product without the need to contact an external authentication server, in the case of a user not being connected with a communication network, as indicated in col. 11 lines 33-39 of Yoshida.

First, Yoshida, does not disclose obtaining a new product key when a product key from the third program and the product key stored in the second data storage unit are not identical by "When the appropriate decryption key does not exist in the decryption key memory unit, the communication program o the installer is executed to carry out the decryption key acquisition processing..." in col. 11 lines 21-24. The appropriate key not existing is not teaching or suggesting that key stored and the key from the third program being not identical.

Furthermore, the Examiner separately mentions an input window from one reference and the product key comparison from another, but fails to mention of the teaching of suggesting of the providing the information window *when* the product key from the third program and the stored product key are not identical. As mentioned above, The Federal Circuit has mentioned that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious." *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*,

416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). The teachings do not mention the connection of the two clauses.

Regarding claim 15, the Examiner states that Yoshida teaches:

- initiating an initial install of a first program on a first data storage unit on a computer system ("installing the decrypted software content into the personal computer..." in col. 5 lines 55-56)
- writing the product key onto a second data storage unit of the computer system ("program code means for causing said computer to store the decryption key ... into the memory device..." in col. 3 lines 57-59)
- initiating a reinstallation of the first program on the computer system ("utilized in decrypting the encrypted software to be re-installed in col. 6 lines 10-11)
- reading the product key from the second data storage unit ("The decryption key stored in this decryption key memory unit will be utilized..." in col. 6 lines 9-10)
- comparing the product key read from the second data storage unit with the product key of the first program ("when the appropriate decryption key exists in the decryption key memory unit..." as stated in col. 11 lines 59-60)
- inputting the product key when the product keys are compared to be identical ("when the appropriate decryption key exists in the decryption key memory unit ... the installment of the decrypted software content ... is carried out by using the decryption key retrieved from the decryption key memory unit... " in col. 11 lines 59-65) substantially as claimed.

Yoshida does not explicitly disclose inputting the product key of the first program, the product key being used for certifying an authenticity of the first program and accommodating an installation of the first program on the computer system, installing the remainder of the first program after writing the product key, inputting the product key into a product key input window, and continuing to complete the reinstallation of the first program after the product key is inputted into the product key window.

Venkatesan discloses in an analogous product key-based installation system inputting a product key for a first program, the product key being used for certifying an authenticity of the first program and accommodating an installation of the first program on the computer system ("will prompt the user to enter the indicia ... the user, in response to this prompt, will then manually enter, typically through a keyboard associated with computer ... the specific 25-digit alphanumeric indicia..." in col. 7 lines 58-63. Further, "a corresponding indicia which itself is uniquely associated with a given copy of a software product, for purposes of authenticating that particular copy during its installation ... this product can be ... an operating system..." in col. 5 line 65 to col. 6 line 13). Venkatesan further discloses installing

the remainder of the first program after writing the product key, inputting the product key into a product key input window, and continuing to complete the reinstallation of the first program after the product key is inputted into the product key window as claimed ("will prompt the user to enter the indicia ... the user, in response to this prompt, will then manually enter, typically through a keyboard associated with computer ... the specific 25-digit alphanumeric indicia..." in col. 7 lines 58-63. Further, "If Authentication process successfully authenticates the indicia entered by the user, then this process so informs installation program ... which, in turn, continues with the installation process..." in col. 8 lines 7-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the installation and product key procedures of Venkatesan with the system of Yoshida, as this would prevent illegal installation of software products onto the computer system by requiring the user to pass an authentication step during the installation process.

First, Yoshida does not teach or suggest the initiating an initial install of a first program on a first data storage unit on a computer system by "installing the decrypted software content into the personal computer..." in col. 5 lines 55-56. The actual step of initiating is not taught or suggested, but just the mere installing of decrypted software.

The Examiner mentions the teaching or suggestion of writing the product key onto a second data storage unit of the computer system by "program code means for causing said computer to store the decryption key ... into the memory device..." in col. 3 lines 57-59. However, when the reference is looked as a whole and the claim is looked as a whole, Figure 7 of Yoshida shows the first program and the key code in the same hard disk drive and not a separate first and second storage units.

The Examiner states that Yoshida does not explicitly disclose inputting the product key of the first program but that Venkatesan does. However, again the Examiner failed to look at the claim as whole as there is the inputting of the product key *when* the product keys are compared to be identical. The connection of the limitations is not taught or suggested by the combined references.

Regarding claim 20, the Examiner stated that rejection of claim 15 is incorporated, and

further, Yoshida discloses:

storing the product key in a specific region of the first data storage unit and the first program continuing to install on the computer system before the step of writing the product key onto a second data storage unit, the product key being written from the product key stored on the first data storage unit ("third computer readable program code means for causing said computer to decrypt the encrypted software by using the decryption key ... and install a decrypted software content into the memory device; and a forth computer readable program code means for causing said computer to store the decryption key acquired ... into the memory device..." in col. 3 lines 51-59. The system inherently stores the key in a temporary location after it receives the key, so that it can decrypt the software. Then the key is saved into memory.)

However, storing the product key and the first program continuing to install is not taught or suggested by Yoshida's col. 3 lines 51-59 as none of the programs mentioned teach or suggest the continuing of the installation as the product key is stored.

C. Claims 12-14, 16, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as Venkatesan, further in view of the Microsoft Press Computer Dictionary, Second Edition. The Applicant respectfully traverses.

Regarding claim 12, the Examiner stated that neither Yoshida nor Venkatesan explicitly disclose the product key comprising a bar code read by a bar code reader, and t Microsoft Press Computer Dictionary, Second Edition discloses that bar code-readable signals capable of being read by an optical scanner were well known in the art at the time, as disclosed on page 37 of the dictionary and it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code-readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary.

Again, as mentioned above, the Examiner is improperly using a dictionary as a reference to teach or suggest a feature of the present invention.

Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with the references and not just a dictionary definition.

Regarding claim 18, the Examiner stated that the rejection of claim 15 is incorporated, and further, neither Yoshida nor Venkatesan explicitly disclose initiating a checksum of the specific regions of the second data storage unit having the product key to ascertain whether the read product key is correct, and the Microsoft Press Computer Dictionary, Second Edition discloses that the act of comparing checksums to detect errors was well known in the art at the time, as disclosed on page 73 of the dictionary, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a checksum comparison on the product keys, as this would help the user determine whether the storage of the product key was successful.

Again, as mentioned above, the Examiner is improperly using a dictionary as a reference to teach or suggest a feature of the present invention.

Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with the references and not just a dictionary definition.

This rejection is quite improper.

Regarding claim 28, the Examiner stated that the rejection of claim 15 is incorporated, and



further, neither Yoshida nor Venkatesan explicitly an extended complementary metal-oxide semiconductor random-access memory having an auxiliary power source, and the Microsoft Press Computer Dictionary, Second Edition discloses that the use of CMOS RAM with an auxiliary power source, providing the ability to preserve stored information when power is removed was well known in the art at the time of the invention as disclosed on page 77 of the dictionary (the CMOS RAM is powered by an external battery source), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CMOS RAM in the system disclosed by Yoshida modified by Venkatesan, for the purpose of storing and retaining information while using very low power consumption when power is removed from the system.

Again, as mentioned above, the Examiner is improperly using a dictionary as a reference to teach or suggest a feature of the present invention.

Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with the references and not just a dictionary definition.

#### **IV. Double Patenting**

The Applicant respectfully traverses the double patenting rejection.

A. Claims 1-5, 7, 8, 10 and 11 are provisionally rejected under the judicially created doctrine of double patenting over claims 11 and 14 of copending Application No. 09/718,371. The Examiner stated that this is a provisional double patenting rejection since the conflicting claims have not yet been patented.

1. The Examiner stated that the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on

that copending application since the referenced copending application and the instant application are claiming common subject matter, as the instant claims 1-10 with co-pending claim 11 and instant claim 11 with co-pending claim 14.

Moreover, the Examiner states that Claims 11 and 14 of copending Application No. 09/718,371 as shown below contains every element of claims 1-5, 7, 8, 10 and 11 of the instant application and as such anticipate claims 1-5, 7, 8, 10 and 11 of the instant application.

The Double Patenting Rejection is improper because it fails to satisfy the provisions set forth by the Manual of Patent Examining Procedure (MPEP) §804 for nonstatutory obviousness-type double patenting as seen below.

The inquiry in a nonstatutory-type double patenting rejection revolves around whether the claims in an application merely define an obvious variation of the other patent. *In re Emert*, 124 F.3d 1458, 44 USPQ 2d 1149, 152 (Fed. Cir. 1997) (citing *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ 2d 2010, 2015 (Fed. Cir. 1993); *In re Vogel*, 422 F.2d at 441, 164 USPQ at 622).

If the application at issue is the later filed application or both are filed on the same day, a one-way determination of obviousness is needed in resolving the issue of double patenting. MPEP §804. Under a one-way test, if the scope of the application and the patent claims is not identical, the court must ask whether the former defines merely an obvious variation of the latter. *In re Goodman*, 11 F. 3d 1046, 29 USPQ 2d 2010, 2015-2016 (Fed. Cir. 1993).

The Examiner as suggested by §804 of the *MPEP*, must provide:

(a) The differences between the inventions defined by their conflicting claims, namely a

comparison of the applied claims of the *Kim et al.* '026 patent and each of the rejected claims in the above-captioned application; and

(b) The reasons why a person of ordinary skill in art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the claim of the patent.

Furthermore, the Federal circuit has held that the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness. See *In re Longi*, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985).

According to MPEP §804, since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35USC§103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35USC§103 are employed when making an obviousness-type double patenting analysis.

Therefore, the first step is for the Examiner to identify the invention claimed. The court of *In re Vogel* inquired the first step as "does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent." *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Therefore, the analysis is based on what the claim defines, and not on the claim language itself. The analysis should not focus on what the claim language discloses, but rather on what the claim language defines. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ 2d 1839, 1845 (Fed. Cir. 1992). Therefore, although the patent disclosure cannot be used as prior art, the disclosure can be used to determine the meaning of the claims in view of the disclosed embodiment. *In re Vogel*, 164 USPQ at 622. The specification is used to help interpret the claims of the patent but the specification cannot be read into the claims in an effort to support a double patenting rejection.

Respectfully, the Examiner has failed to provide a proper foundation for a double patenting rejection. Further, even looking at the pending claims 11 and 14 of the co-pending application, the claims do not define claims 1-5, 7, 8, 10 and 11 of the present in invention as seen below.

The Examiner stated that per claim 1: Copending claim 11 teaches:

- a computer system, comprising a first data storage unit storing a first program and a second program ("said computer system using an operating system program stored on a hard disk in said hard disk drive ... executing a key input program stored on said hard disk...")

- a second data storage unit storing a product key of the first program according to the second program, the product key accommodating an installation of the first program ("product key information corresponding to said operating system program ... writing said product key information into a predetermined storage area of said CMOS RAM")

- a third program stored in the first data storage unit for reinstalling the first program

("executing a recovery program stored in a recovery storage device")

- the third program reading the product key of the first program stored in the second data storage unit, when a product key from the third program and the product key stored in the second data storage unit are identical ("reading out said product key information from said CMOS RAM with said recovery program is executed; comparing said product key information read out ... with product key information stored in said recovery storage device; and automatically inputting the product key information") as claimed.

First, it is not what co-pending claim 11 teaches, but what co-pending claim 11 defines.

Secondly, the Examiner stated above that the co-pending claim 11 teaches the third program reading the product key of the first program stored in the second data storage unit, when a product key from the third program and the product key stored in the second data storage unit are identical ("reading out said product key information from said CMOS RAM with said recovery program is

executed; comparing said product key information read out ... with product key information stored in said recovery storage device; and automatically inputting the product key information") as claimed. A comparison is defined but the actual product key from the third program and the product key stored in the second data storage unit being identical is not defined by co-pending claim 11.

Regarding claim 2, the Examiner stated that the rejection of claim 1 is incorporated, and further, copending claim 11 discloses the first program being an operating system as claimed ("using an operating system program").

First, it is not what co-pending claim 11 discloses, but what co-pending claim 11 defines.

Regarding claim 3, the Examiner stated that the rejection of claim 1 is incorporated, and further, copending claim 11 discloses the first data storage unit comprising a first unit storing the first program and a second unit storing the third program as claimed ("said computer system using an operating system program stored on a hard disk in said hard disk drive ... executing a key input program stored on said hard disk ...").

First, it is not what co-pending claim 11 discloses, but what co-pending claim 11 defines. Furthermore, the actual first and second unit of the first data storage unit is not defined as a hard disk drive is mentioned to store both programs only in the claim.

Regarding claim 4, the Examiner stated that the rejection of claim 3 is incorporated, and further, copending claim 11 discloses the second program being stored in the first unit or the second unit as claimed ("executing a key input program stored on said hard disk ...").

As mentioned above the first and second parts are not defined by the copending claim.

Regarding claim 7, the Examiner stated that rejection of claim 1 is incorporated, and further, copending claim 11 discloses the third program being provided with an information input window to allow a user to directly input the product key, when a product key from the third program and the product key stored in the second data storage unit being not identical as claimed ("product key information being input into a product key input window of a product key input screen...").

However, copending claim 11 does not define when the product key from the third program and the product key stored in the second data storage unit being not identical with each other.

Regarding claim 8, the Examiner stated that the rejection of claim 1 is incorporated, and further, copending claim 11 discloses an extended complementary metal-oxide semiconductor random-access memory, the second data storage unit being accommodated in the extended complementary metal-oxide semiconductor random-access memory as claimed ("writing said product key information into a predetermined storage area of said CMOS RAM").

However, co-pending claim 11 does not define an extended metal-oxide semiconductor random access memory accommodating the second data storage unit, but mentions the CMOS RAM.

B. Claims 6, 9 and 12 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 09/718,371 in view of the Microsoft Press Computer Dictionary, Second Edition.

Regarding claim 6, the Examiner stated that the rejection of claim 1 is incorporated, and further, copending claim 11 does not explicitly disclose the product key being a bar code-readable signal, and the Microsoft Press Computer Dictionary, Second Edition discloses that bar code-readable signals were well known in the art at the time, as disclosed on page 37 of the dictionary, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code-readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary.

Again, as mentioned above, the use of the dictionary as reference for an entire limitation as improper and should not be used. Furthermore, the Applicant asks the Examiner to provide an actual prior art reference that can be combined with the other references.

Regarding claim 9, the Examiner stated that rejection of claim 1 is incorporated, and further, copending claim 11 does not disclose the extended complementary metal-oxide semiconductor random-access memory having an auxiliary power source, and the Microsoft Press Computer Dictionary, Second Edition discloses that the use of CMOS RAM with an auxiliary power source, providing the ability to preserve stored information when power is removed was well known in the art at the time of the invention as disclosed on page 77 of the dictionary (the CMOS RAM is powered by an external battery source), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CMOS RAM in the method disclosed in copending claim 11, for the purpose of storing and retaining information while using very low power consumption when power is removed from the system.

Again, as mentioned above, the use of the dictionary as reference for an entire limitation as improper and should not be used. Furthermore, the Applicant asks the Examiner to provide an actual prior art reference that can be combined with the other references.

Regarding claim 12, the Examiner stated that Copending claim 11 t does not explicitly disclose reading the product key comprised of a bar code by a bar code reader, but the Microsoft Press Computer Dictionary, Second Edition discloses that bar code-readable signals capable of being read by an optical scanner were well known in the art at the time, as disclosed on page 37 of the dictionary, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code-readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary.

Again, as mentioned above, the use of the dictionary as a reference for an entire limitation as improper and should not be used. Furthermore, the Applicant asks the Examiner to provide an actual prior art reference that can be combined with the other references.

This provisional obviousness-type double patenting rejection is improper.

C. Claims 15 and 17 21-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 14 and 20 of copending Application No. 09/718,371 in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as Venkatesan.

As mentioned above, the Examiner has failed to provide the foundations of an obviousness type double patenting rejection.

Furthermore, the Examiner has failed to show that all the limitations of the present invention



are defined in the co-pending claims.

Regarding claim 15, the Examiner stated that Copending claim 11 teaches:

- inputting a product key of the first program ("manually inputting ... product key information corresponding to said operating system program")
- writing the product key onto a second data storage unit of the computer system ("writing said product key information into a predetermined storage area of said CMOS RAM")
- initiating a reinstallation of the first program on the computer system ("executing a recovery program stored in a recovery storage device")
- reading the product key from the second data storage unit, comparing the product key read from the second data storage unit with the product key of the first program, inputting the product key into a product key input window of the first program when the product keys are compared to be identical ("reading out said product key information from said CMOS RAM with said recovery program is executed; comparing said product key information read out...with product key information stored in said recovery storage device; and automatically inputting the product key information") as claimed.

The Examiner states that copending claim 11 does not explicitly disclose initiating an initial install of a first program, however, the act of manually inputting product key information is well known to occur during installation of a product.

Copending claim 11 further does not explicitly disclose the steps of using the product key for certifying an authenticity of a first program and accommodating an installation of the first program, installing the remainder of the first program after writing the product key, and continuing to complete the reinstallation of the first program after the product key is inputted into the product key window. Venkatesan discloses in an analogous product key-based installation system the steps of using the product key for certifying an authenticity of a first program and accommodating an installation of the first program, installing the remainder of the first program after writing the product key, and continuing to complete the reinstallation of the first program after the product key is inputted into the product key window as claimed ("a corresponding indicia which itself is uniquely associated with a given copy of a software product, for purposes of authenticating that particular copy during its installation ... this product can be ... an operating system..." in col. 5 line 65 to col. 6 line 13. Further, "will prompt the user to enter the indicia ... the user, in response to this prompt, will then manually enter, typically through a keyboard associated with computer ... the specific 25-digit alphanumeric indicia..." in col. 7 lines 58-63. Further, "If Authentication process successfully authenticates the indicia entered by the user, then this process so informs installation program ... which, in turn, continues with the installation process..." in col. 8 lines 7-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the installation and product key procedures of Venkatesan with the method disclosed in

compending claim 11, as this would prevent illegal installation of software products onto the computer system by requiring the user to pass an authentication step during the installation process.

The Examiner states that compending claim 11 does not explicitly disclose initiating an initial install of a first program, however, the act of manually inputting product key information is well known to occur during installation of a product. Here, the Examiner provides no reference, but the Examiner's own knowledge. Therefore, in such a case, it is the right of the Applicant to demand a reference be provided or an affidavit from the Examiner that such is known in the prior art.

Regarding claim 18, the Examiner stated that the rejection of claim 15 is incorporated, and further, compending claim 20 discloses initiating a checksum of the specific regions of the second data storage unit having the product key to ascertain whether the read product key is correct ("checking a checksum of said product key information read out from said CMOS RAM").

However, the Examiner failed to show how compending claim 20 defines the initiating of the check sum and the check sum of the specific regions of the second data storage unit.

Regarding claim 20, the Examiner stated that the rejection of claim 15 is incorporated, and further, compending claim 11 discloses storing the product key in a specific region of the first data storage unit and the first program continuing to install on the computer system before the step of writing the product key onto a second data storage unit, the product key being written from the product key stored on the first data storage unit ("executing a key input program stored on said hard disk for writing said product key information into a predetermined storage area of said CMOS RAM.")

However, it is not clear how the Examiner defines all the limitations of claim 20 by "executing a key input program stored on said hard disk for writing said product key information into a predetermined storage area of said CMOS RAM".

Regarding claim 23 and 24, the rejection of claim 22 is incorporated, and further, copending claim 11 discloses the first data storage unit comprising a first unit storing the first program and a second unit storing the third program as claimed ("said computer system using an operating system program stored on a hard disk in said hard disk drive ... executing a key input program stored on said hard disk...").

However, the Examiner failed to define the first and second units in the copending claims.

Regarding claim 27, the Examiner stated that the rejection of claim 23 is incorporated, and further, copending claim 11 discloses the third program being provided with an information input window to allow a user to directly input the product key, when a product key from the third program and the product key stored in the second data storage unit being not identical as claimed ("product key information being input into a product key input window of a product key input screen...").

However, the Examiner failed to provide how the copending claim defines when a product key from the third program and the product key stored in the second data storage unit being not identical.

D. Claims 16 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 09/718,371 in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as

Venkatesan, further in view of the Microsoft Press Computer Dictionary, Second Edition.

Regarding claim 16, the Examiner stated that the rejection of claim 15 is incorporated, and further, neither copending claim 11 nor Venkatesan explicitly disclose inputting the product key through a bar code reader, and the Microsoft Press Computer Dictionary, Second Edition discloses that bar code-readable signals were well known in the art at the time, as disclosed on page 37 of the dictionary, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to represent the product key as a bar code-readable signal, as this would allow rapid, error-free input of the information as disclosed on page 37 of the dictionary.

Again, it is improper to use the Dictionary in the rejection, and therefore, the rejection if improper.

Regarding claim 28, the Examiner stated that the rejection of claim 15 is incorporated, and further, neither copending claim 11 nor Venkatesan explicitly an extended complementary metal-oxide semiconductor random-access memory having an auxiliary power source, but the Microsoft Press Computer Dictionary, Second Edition discloses that the use of CMOS RAM with an auxiliary power source, providing the ability to preserve stored information when power is removed was well known in the art at the time of the invention as disclosed on page 77 of the dictionary (the CMOS RAM is powered by an external battery source), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CMOS RAM in the method disclosed by copending claim 11 modified by Venkatesan, for the purpose of storing and retaining information while using very low power consumption when power is removed from the system.

Again, the Examiner is improperly using a dictionary as a reference to teach or suggest a

feature of the present invention. There is also no motivation or suggestion to include a CMOS RAM having an auxiliary power source in the other references, especially when the Examiner admits the CMOS RAM is not even close to being taught or suggested. Here, the Examiner is even using the definitions of parts as motivation to combine which is improper and generalized and not particular to the present invention.

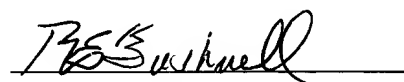
Therefore, again, as mentioned above, it is the right of the Applicant to ask the Examiner to provide an actual reference that can be combined with the references and not just a dictionary definition.

Therefore, this provisional obviousness-type double patenting rejection is improper.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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